

Application No. 10/047,817

Reply to Office Action

*REMARKS/ARGUMENTS**Summary of the Office Action*

The Office maintains the rejection of claims 1-4, 6-9, 11-32, and 52-58 under 35 U.S.C. § 103(a) as allegedly obvious over Hollenberg et al. (U.S. Patent No. 5,143,722) in view of Collin et al. (U.S. Patent No. 5,656,672) and Guthauser (U.S. Patent No. 5,162,378). In addition, claims 1-4, 6-9, 11-32, and 52-58 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over Stepniewski et al. (U.S. Patent No. 5,599,533) in view of Rapaport (U.S. Patent No. 5,730,991) and Dorogi et al. (U.S. Patent No. 5,882,661).

Discussion of Rejections

The Examiner suggested that additional inventive examples to illustrate the claim breadth and unexpected results would be beneficial to advance prosecution. Submitted herewith is a declaration by the inventor (Third Declaration Under 37 C.F.R. § 1.132 of Richard A. Brown) illustrating the superior stability of three additional inventive examples (i.e., Samples E, F and G). All three inventive examples had varying amounts of the oil phase, aqueous phase, pigments, cetyl dimethicone copolyol, and/or elastomer, as recited in the pending claims. Each of the additional examples was stable for at least 3 months at 50 °C.

The additional results demonstrate that varying compositions of the present invention (particularly, compositions comprising about 3-6 wt% cetyl dimethicone copolyol) were stable for at least three months at 50 °C. The increase in stability exhibited by a composition of the present invention is surprisingly greater than compositions comprising an amount less than or greater than about 3-6 wt% of an emulsifier comprising a cetyl dimethicone copolyol, as evidenced by the specification and the current and previous Rule 132 declarations.

The combination of Hollenberg et al., Collin et al., and Guthauser does not render the present inventive composition obvious. As previously discussed, Hollenberg et al. teaches away from adding an emulsifier that either (a) contains silicone or (b) contains alkyl substituents with *more* than 6 carbons. Cetyl dimethicone copolyol contains silicone *and* alkyl substituents with more than 6 carbons. Even though Collin et al. describes the use of 1-6 wt% of a silicone-containing emulsifying agent (col. 3, lines 39-50), including the use of a

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cetyl dimethicone copolyol, one of ordinary skill in the art would not even look to Collin et al.'s disclosure because Hollenberg et al. expressly teaches that silicone-containing emulsifying agents such as cetyl dimethicone copolyol should *not* be used. Without a proper *prima facie* case of obviousness and with no motivation for one of ordinary skill in the art to combine the disclosures of Hollenberg et al., Collin et al., and Guthauser, claims 1, 7-9, 11-32, and 53-58 are unobvious. Accordingly, the obviousness rejection in view of these references should be withdrawn.

The combination of Stepniewski et al., Rapaport, and Dorogi et al. does not render the present inventive compositions obvious. Rapaport and Dorogi et al. do not even mention the use of a cetyl dimethicone copolyol in any amount, let alone in the amount of about 3-6 wt%. Stepniewski et al. broadly describes the use of a surfactant in the range of about 0.01-20 wt%.

Applicant has unexpectedly discovered that adding about 3-6 wt% of a cetyl dimethicone copolyol emulsifier to the water-in-oil emulsion lends unusual stability to the present invention. It cannot be said that Stepniewski et al. renders the present invention obvious, since Stepniewski et al. clearly does not appreciate any benefit in providing a composition comprising about 3-6 wt% of a cetyl dimethicone copolyol. It is only with the impermissible use of hindsight that one might allege that Stepniewski et al. teaches a composition of the present invention.

In view of these surprising and unexpected results, and without the motivation to include about 3-6 wt% of a cetyl dimethicone copolyol as an emulsifier to a water-in-oil emulsion based on the disclosures of Stepniewski et al., Rapaport, and Dorogi et al., claims 1-4, 6-9, 11-32, and 52-58 are unobvious. Accordingly, the obviousness rejection in view thereof should be withdrawn.

Conclusion

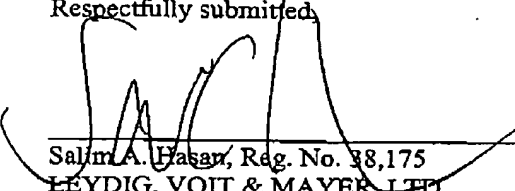
Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

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Respectfully submitted,



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